



UNITED STATES DEPARTMENT OF COMMERCE
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Washington, D.C. 20231

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 23

Application Number: 08/685,338
Filing Date: July 23, 1996
Appellant(s): Wang et al.

William E. Anderson II
For Appellant

MAILED
NOV 10 1999
Group 3700

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed March 29, 1999.

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(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claim 11 stands or falls alone because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

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The rejection of claims 12-14 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

The rejection of claim 15 stand or falls alone because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

The rejection of claims 16-17 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

The rejection of claim 35 stand or falls alone because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

The rejection of claim 36 stand or falls alone because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

The rejection of claim 37 stand or falls alone because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

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The rejection of claims 38-39 and 45 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

The rejection of claims 40-42 and 44 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

The rejection of claims 43 stand or falls alone because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

The rejection of claims 46-47 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

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5,344,400

KANEKO ET AL

9-1994

5,167,239

COHEN ET AL

12-1992

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

2. Claim 11 is rejected under 35 U.S.C. 102(e) as being anticipated by Anderson et al(5,500,180).

Anderson et al. discloses a thermoplastic polymer material balloon, where the thermoplastic polymer material is a block copolymer material.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 12-17, 35-42, 44 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson et al(5,500,180).

Anderson et al. disclose the invention substantially as claimed. However, Anderson et al. does not disclose all the different variations of inflation pressure and diameter as claimed by Applicant. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Anderson et al. by providing to his balloon with a different variation of inflation pressure and diameter by varying and controlling the balloon expansion and heating processes as evidenced by Anderson et al. at the process of making such balloon.

5. Claim 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson et al. in view of Kaneko et al(5,344,400).

Anderson et al. discloses the invention substantially as claimed. However, Anderson et al. does not disclose the balloon formed from at least two concentric layers of different thermoplastic polymers.

Kaneko et al. teaches a balloon having at least two concentric layers of different thermoplastic polymers for the purpose of stability and flexibility. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Anderson et al. by providing the at least two concentric layers of different thermoplastic polymers as shown by Kaneko et al. in order to improve the stability and flexibility of the balloon.

6. Claims 46 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson et al. in view of Cohen et al(5, 167,239).

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Anderson et al. discloses the invention substantially as claimed. However, Anderson et al. does not disclose a method of treating a gastrointestinal lesion having the steps as claimed by Applicant.

Cohen et al. teaches an anchorable guidewire for treating a gastrointestinal lesion having the steps as claimed by Applicant(see col. 42-55 and throughout the specification). It would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute the guidewire of Cohen et al. with the Anderson's et al.'s catheter and treat a gastrointestinal lesion using the steps taught by Cohen et al. where substituting one device for the other would have been obvious depending on Applicant's intention.

(11) Response to Argument

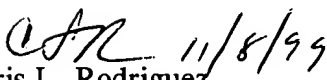
In response to Appellant's arguments that the shrinking process used in the invention is quite different from the heat set technique used in the Anderson et al. reference, the Examiner direct Appellant's attention to the M.P.E.P 2113 and 2173.05(p), where clearly set forth that a "Product by Process Claims" are not limited to the manipulations of the recited steps, but only the structure implied by the steps. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the


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product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). Because the claims are product by process claims, determination of patentability is based on the product itself. Although, Anderson et al. disclose a method of making a balloon with the step of balloon expansion under a first elevated temperature to form a balloon first diameter(col. 11 lines 14-28) and further step of applying heat to the balloon. Obviously, applying a different second elevated temperature would have been an obvious variation from the product of the prior art.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


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November 8, 1999


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